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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,437	08/21/2003	Dennis Michael Bondy	BDD-10003/04	9488
25006	7590	05/03/2005	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C			MORAN, KATHERINE M	
PO BOX 7021			ART UNIT	PAPER NUMBER
TROY, MI 48007-7021			3765	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/646,437	BONDY, DENNIS
	Examiner	Art Unit
	Katherine Moran	3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 21 August 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 1-5 is/are allowed.

6)  Claim(s) 6-8 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 August 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/2/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Reissue Applications***

1. Claims 6-8 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Regarding Applicant's newly presented claim 6, this claim has been broadened in that the claim omits subject matter which was previously added to independent claim 1 in order to put the claim in condition for allowance and to read over the cited prior art. The subject matter which has been omitted is as follows: "second end of said clips each having a spherical socket so that said spherical sockets face each other, ....each post having a spherical ball such that said spherical balls face away from each other..."

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Claims 7 and 8 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: "pair of posts secured to said frame each have a spherical socket such that said spherical sockets face away from each other" (claim 7) and "second end of each clip has a spherical ball such that the spherical balls face each other" (claim 8).

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 11/2/04 was filed after the mailing date of the pending application on 8/21/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Terminal Disclaimer***

3. The terminal disclaimer filed on 8/25/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the U.S. 6,275,992 patent has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitations "said first end" and "said second end". There is insufficient antecedent basis for these limitations in the claim. Regarding claim 7, it is unclear how the sockets will face away from each other when the clips are secured at their first ends, to the hat brim as recited in claim 6. Also, it is unclear how the balls can face each other when the eye shield assembly is mounted to the hat brim. It appears that Applicant is attempting to recite a second embodiment or configuration for the ball and socket assembly for which there is no support in the specification or in the drawings.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (U.S. 2,519,959). Fisher discloses the invention as claimed. Fisher teaches an eye shield assembly comprising a frame 24, a lens 18 mounted to the frame, means for pivotally mounting the frame to the hat between a storage position and an operational position, wherein in the storage position, the lens nests closely adjacent to the brim

(Figure 4) and wherein in the operational position the lens depends downwardly from the brim. The pivotal mounting means comprises a pair of clips 13, each clip having ends, with one clip attached at the first end to one side of the brim, and the other clip being attached at the first end to the other side of the brim. A pair of posts 23 are secured to the frame 24, so that one post is adjacent one end of the frame and the other post is adjacent the other end of the frame. A ball and socket joint 14 is provided between each post and second clip end to provide for the pivotal mounting of the frame to the hat. The pair of posts 23 each have a spherical socket 22 such that at least portions of the sockets face away from each other. The second end of each clip 13 has a spherical ball 21 such that the balls face each other and are dimensioned to be received in the posts' sockets.

8. Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Feldman (U.S. 2,691,164). Feldman discloses the invention as claimed. Feldman teaches an eye shield assembly comprising a frame 24, a lens 22 mounted to the frame, means for pivotally mounting the frame to the hat between a storage position and an operational position, wherein in the storage position, the lens nests closely adjacent to the brim (Figure 1) and wherein in the operational position the lens depends downwardly from the brim. The pivotal mounting means comprises a pair of clips 50, each clip having ends, with one clip attached at the first end to one side of the brim, and the other clip being attached at the first end to the other side of the brim. A pair of posts 34,36 are secured to the frame 24, so that one post is adjacent one end of the frame and the other post is adjacent the other end of the frame. A ball and socket joint is provided between

each post and second clip end to provide for the pivotal mounting of the frame to the hat. The pair of posts each have a spherical socket at 40 such that at least portions of the sockets face away from each other. The second end of each clip has a spherical ball 42 such that the balls face each other and are dimensioned to be received in the posts' sockets.

***Allowable Subject Matter***

9. Claims 1-5 are allowed.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (703) 872-9306. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

April 27, 2005



Katherine Moran

Primary Examiner, AU 3765